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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Martin A. Kenner

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10/27/2005

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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,191

Applicant(s)

KENNER ET AL

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 and 78-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-76 and 78-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/27/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-76 and 78-85 have been examined.

#### *Response to Amendment*

2. The Amendment filed on 9/12/05 is sufficient to overcome the prior rejection. Please see the new rejection below.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-76 and 78-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles (5,933,811) in view of Goldhaber (5,794,210).

Angles discloses posting a note on a first computer at a content provider, wherein the note has content, and wherein the content provider is a first party (Fig. 4; Fig. 6; Fig. 9; Fig. 10);

electronically engaging in an activity arising from the content of the note, wherein the activity is performed by a content recipient on a second computer, and wherein the content recipient is a second party (col 21, lines 25-30); and,

providing payment to a third party based upon the activity (col 4, lines 40-47; Abstract, 'credits an internet provider account').

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Notice in Angles that a reference for advertising can be placed at the content provider (Fig. 4 and Fig. 6) and that advertisements can be downloaded to the user directly from the advertisement provider (Fig. 10) and/or thru the content provider who obtains the advertisements from the advertisement provider (Fig. 9) and/or thru from the consumer/recipient computer which downloaded the advertisements from the advertisement provider computer (Fig. 4).

Also, notice in the above citations that the note can be downloaded without resorting to a cut or copy operation and without downloading a web page of the content provider.

As disclosed above, Angles discloses the users being rewarded for viewing the advertisement/note. Angles further discloses the user making purchases online and performing other online activities such as clicking on an advertisement/note to access more information about a product (col 6, lines 15-31; col 4, lines 5-16).

Angles does not explicitly disclose the user being rewarded for these other activities.

However, Goldhaber discloses the user being rewarded for a variety of activities incited by an advertisement/note (col 7, lines 60-65; Claim 14; col 11, lines 31-40).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's rewarding a variety of activities to Angle's user performing a variety of activities of interest to an advertiser and an advertiser rewarding a user for advertisement related activity. One would have been motivated to do this in order to provide more capability for inciting and rewarding different user actions of interest.

In particular regards to claims 70, 72, 74, Examiner notes that Goldhaber discloses these features. Goldhaber further discloses the utilization of icons (Fig. 4; col 11, lines 7-25).

Examiner notes that icons are draggable and droppable.

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Goldhaber further discloses drag and drop content:

“(59) The World Wide Web allows anyone to maintain public "home pages" that are visible to all, and are accessible to all with optional name-password access restrictions. The system provided by the present invention adds the capability of maintaining private home pages that are accessible and visible only to their owners. Another example feature of these pages is the capability of "dragging and dropping" content between one's private and public home pages” (col 8, lines 50-57).

In particular regards to claims 78, 79, 80, Examiner notes that the note can be automatically downloaded to the recipient separately from the web page (Angles, Fig. 10).

In particular regards to claim 85, Examiner notes that the content can suggest something (Angles, col 2, lines 4-12; col 4, lines 5-17).

Also, Angles discloses utilizing Internet service providers, content providers, advertisement providers, and user computers (col 4, lines 26-47; Abstract; Fig. 2).

Angles discloses that a variety of parties such as the content provider, internet service provider, or user can be rewarded for performing certain actions:

“(104) In addition, the ability to monitor the number of advertisements displayed by a particular content provider computer 14 provides a number of advantages. For example, the advertisement provider can pay the content provider based on the volume of advertisements actually displayed by the content provider computer 14. This frees the content providers from having to generate advertising data, from having to individually contact advertisers, from having to negotiate advertising payment fees, and from having to maintain an advertising administrative staff;

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(105) Furthermore, because the preferred embodiment also is capable of storing a consumer's Internet provider account number in the registration database 68, the preferred embodiment can monitor the number of advertisements viewed by consumers associated with a particular Internet provider 34. Accordingly, the invention can pay an Internet provider 34 based on the number of advertisements viewed by its consumers. The Internet providers 34 can then use this advertising revenue to reduce consumer access fees. Alternatively, the preferred embodiment can pay a consumer for viewing advertisements by crediting a consumer's Internet provider account;

(106) In addition, because the preferred embodiment also is capable of storing a consumer's digital cash account, the preferred embodiment can pay the consumer with digital cash each time the consumer views an advertisement. This allows the consumer to obtain digital cash which the consumer can use to purchase other goods and services offered for sale on the Internet 33" (col 16, lines 15-45).

Angles discloses sending information/note from consumer computer to user computer:

"(140) Proceeding to state 802, the advertising module 62 selects and retrieves the customized advertisement 30 from the advertising database and sends the customized advertisement 30 to the consumer. In the preferred embodiment, the customized advertisement 30 is stored in a HTML format, and the advertising module 62 uses the HTTP protocol to send the customized advertisement 30 to the consumer computer 12, where the customized advertisement 30 is displayed within the electronic page sent to the consumer computer" (col 20, line 64-col 21, line 5).

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Angles discloses that the user selects advertisement to receive more information on that advertisement:

“(136) If the consumer desires to obtain more information about a good or service appearing in a customized advertisement 30, the consumer selects the customized advertisement 30 and proceeds to state 718. When the consumer selects the customized advertisement 30 during state 718, the consumer control module 42 sends a message to the advertising module 62 that the consumer has selected the customized advertisement 30. In response, the advertising module 62 stores the message in the accounting database 72” (col 20, lines 17-27).

Angles discloses that a content provider can provide wide range of services to the user:

“(148) The embodiment shown in FIG. 9 allows the customized advertisements 30 to be incorporated directly into the content provider's offerings. Thus, in addition to integrating the customized advertisements 30 in to an electronic page 32, the content provider computer 14 can integrate the customized advertisements 30 into offerings such as on-line games, video programming, internet radio, virtual reality environments and the like” (col 21, lines 51-60).

Angles discloses downloading the note separate from the regular content:

“(15) In the preferred embodiment, the invention is directed to delivering custom advertisements to consumers who use their computers to view information offered by different content providers existing on the Internet. Preferably, when a consumer accesses a content provider, the content provider transmits an electronic document to the consumer. Embedded within the electronic document is a advertisement request. When the consumer's computer displays the electronic document, the embedded advertisement request directs the consumer

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computer to communicate with an advertisement provider. In response, the advertisement provider provides a customized advertisement. The advertisement provider then tracks the consumer's response to the customized advertisement (col 2, line 59-col 3, line 5);

(140) Proceeding to state 802, the advertising module 62 selects and retrieves the customized advertisement 30 from the advertising database and sends the customized advertisement 30 to the consumer. In the preferred embodiment, the customized advertisement 30 is stored in a HTML format, and the advertising module 62 uses the HTTP protocol to send the customized advertisement 30 to the consumer computer 12, where the customized advertisement 30 is displayed within the electronic page sent to the consumer computer" (col 20, line 64-col 21, line 5).

Goldhaber discloses drag and drop content:

"(59) The World Wide Web allows anyone to maintain public "home pages" that are visible to all, and are accessible to all with optional name-password access restrictions. The system provided by the present invention adds the capability of maintaining private home pages that are accessible and visible only to their owners. Another example feature of these pages is the capability of "dragging and dropping" content between one's private and public home pages" (col 8, lines 50-57).

Goldhaber discloses rewarding a user for a wide range of activities related to the note/information/advertising such as providing information, downloading the ad, viewing the content, interacting with content, taking a quiz, etc (col 7, lines 20-62).

Goldhaber discloses transferring/sending/downloading information/note/advertisement content to the user computer (Fig. 4 and below):



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“(10) The consumer has an incentive to do this because she knows that this action will transfer compensation or some other incentive represented by the CyberCoin icon 62 to her credit. Clicking on this CyberCoin 62 may institute an automatic retrieval, over network 102, of the ad information the CyberCoin is associated with (col 11, lines 19-25);

(18) This consumer interest profile 124 information can be used by advertisers 62 to target advertisements selectively to certain consumers and not to others (e.g., teenage boys can be sent skateboard ads, mothers can be sent children's clothing ads, retirees can be sent conservative investment information, golfers can be sent golf product ads, etc.). In the case of direct payment using digital cash, consumer database 120 may also include a digital cash repository 126 as discussed above (col 12, lines 29-38);

[Claim 2] (a) supplying said negatively priced information from said information provider to said attention broker computer; and

(b) selectively delivering the negatively priced information via the computer network from the attention broker computer to the personal computer.

3. A method as in claim 2 wherein supplying step (a) comprises transmitting the negatively priced information from a computer associated with said information provider over the network to said attention broker computer (col 22, lines 1-10);

(76) Agent 110 may present the user's interest profile 124 to attention brokerage servers 106 so as to allow the servers to attempt to match ads within their repertoires 140 with the consumer's interest profile, or in another embodiment, the software agent 110 may maintain the interest profile 124 as confidential and perform the matching itself based on ad profile criteria

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presented by the attention brokerage servers 106. When matches are found, the attention brokerage servers 106 may deliver the matching ads to the consumer's computer 104, or agent 110 may retrieve the ads. Alternatively, the software agent 110 may retrieve a "thumbnail" brief summary of the ads and display them on the consumer's computer display (see FIG. 11). In this example, each "thumbnail description" of an ad can be displayed by consumer computer 104 with an associated CyberCoin icon 62;

(77) As explained in connection with FIG. 4, when a consumer "clicks" on the associated CyberCoin icon 62, this may initiate retrieval of the associated advertisement described in the "thumbnail description" and display of the advertisement on the consumer's computer 104. The advertisement display may ask the consumer questions or otherwise require consumer interaction to ensure the consumer has paid attention to the advertisement. Upon successful completion of this process, an amount of digital currency may be deposited into the consumer's digital cash repository 126, or alternatively, the consumer's account may be credited and the advertiser's account debited by financial clearinghouse computer 108" (col 15, line 55-col 16, line 17).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-76 and 78-85 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes from Applicant's Specification (20020143618) that the 'note' of the Applicant's claims can take a variety of forms including advertising:

"[0022] In accordance with the present invention, one or more of the content

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providers 12A, 12B, 12C, . . . , 12n may carry web pages such as a web page 20 shown in FIG.

2. The web page 20 is meant to be exemplary only and may have any other format as desired.

The web page 20 as shown in FIG. 2 has a plurality of elements such as a note 22, which may be a Software Post-it Note.RTM. provided by 3M, an advertising banner 24, a graphic 26, and text 28. The web page 20 may be provided by the content provider who posts the web page 20, or the web page 20 may be provided by third parties who may or may not pay the content provider to offer the web page 20. Alternatively, third parties may or may not pay the content provider to simply add material to the content provider's own web page. As is known, re-direct URLs may be embedded in the advertising banner 24, the graphic 26, and/or the text 28 in order to re-direct the content recipient to other web pages posted by the content provider who posts the web page 20 or to the web pages of other content providers”.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran  
Patent Examiner  
10/20/2005